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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/358,653	07/23/1999	JOHN M. HILLMAN	CITI0092-US	1816

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EXAMINER

KYLE, CHARLES R

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 11/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	09/358,653	HILLMAN ET AL.	
	Examiner	Art Unit	
	Charles R Kyle	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-6, 9-12 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-6, 9-12 and 16-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 12 is rejected under 35 U.S.C. 102(e) as being anticipated by Shurling et al.

Regarding Claim 12, Shurling et al disclose the invention as claimed including in a method for leveraging a financial relationship between a customer of a financial institution and a financial institution (Summary of the Invention), the steps of:

establishing a financial account at the financial institution for the benefit of the customer (Col. 5-27) ;

adding value to financial accounts at predetermined intervals, wherein the value is comprised of immediate access value (Col.1, line 18, "checking account" which contains value

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immediately accessible to customer and deposited and controlled by the customer; Col. 3, lines 12-26) and vested access value (Col. 1, lines 26-27, “reduced banking fees”) which are vested value (Col. 11, line 46 to Col. 12, line 35; Col. 15, lines 9-24), and further wherein the immediate access value is added to the first financial account by the customer in an amount determined by the customer and at the direction of the customer (Col.1, line 18, “checking account” which contains value immediately accessible to customer (checking account deposits immediately accessible to customer); Col. 3, lines 12-26);

calculating the vested access value by

(a) determining a number of individual components comprising the financial relationship (Col. 11, lines 11-30),

(b) calculating an individual value for each of the individual components at the end of a set period of time (Col. 10, line 65 to Col. 12, line 56),

(c) multiplying the determined individual value of each of the individual components by a pre-selected percentage to obtain a vested access value (Col. 11, line 58 to Col. 12, line 8, particularly Col. 11, lines 64-66); and

(d) adding the vested access value to the financial account (Col. 13, line 62 to Col. 14, line 3), wherein the immediate access value is retrievable by the customer from the financial account without restriction (Col. 3, lines 12-26), but the vested access value is only retrievable by the customer after a predetermined period of time (Col. 1, line 55 to Col. 2, line 5).

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As noted above, Shurling discloses a program where immediately accessible, depositor controlled accounts are established as are incentive award accounts where vesting must occur to realize benefit of the awards. As well, Shurling discloses that immediate access and vested value amounts are held in a single account. In this instance, within a checking account accessible and controlled by the customer, a value, reduced banking fees can be vested per a proportional scheme. See cites set forth above for the specific locations for support of this argument.

Claims 3-6, 9-11 and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shurling et al in view of Ferguson et al.

Regarding Claim 3, Shurling et al disclose the invention substantially as claimed including in a method for leveraging a financial relationship between a customer of a financial institution and a financial institution (Summary of the Invention), the steps of:

a) collecting financial relationship information separately from each of the customer (Col. 4, lines 51-56) and the financial institution (Col. 4, lines 34-39);

b) evaluating the financial relationships between the customer and the financial institution based on the financial relationship information (Col. 2, line 63 to Col. 3, line 11);

c) awarding a total value to the customer based on the evaluation of the financial relationships (Col. 2, lines 46-62);

Shurling does not specifically inclusion of a third party and its relationships or the details of holding, transferring and redeeming a total value award. Ferguson discloses relationships between a customer and a third party (Col. 6, lines 16-22 and collecting information from the third party and evaluation of relationship with the third party (Col. 6, lines 33-48). Ferguson discloses a further relationship between a customer and a bank as a bank account into which third party awards are transferred. See Ferguson at Col. 5, lines 41-46.

Ferguson further discloses:

d) holding the total value award in a first financial account located at the financial institution (Col. 7, lines 8-62; Fig. 1, element 26);

e) selecting a second financial account located at the financial institution into which the total value award is transferred upon expiration of the predetermined period of time (Fig 1, element 30); and

f) redeeming the total value award into the second financial account upon expiration of the predetermined period of time (Fig. 1, element 28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the customer-third party relationship and information in the awarding of value of Ferguson in the method of Shurling because this would have encouraged customers to

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complete transactions with a third party (Ferguson, Col. 1, lines 48-64, while providing a centralized and simple method of evaluating relationship activity (Shurling, Summary of the Invention).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the option of transferring award amounts in the fashion described in Ferguson et al in the financial leveraging system disclosed by Shurling et al because this would have provide a consolidated account for distribution of awards and would have facilitated tracking and auditing of accounts to which awards were made. It would further have been obvious to have utilized a predetermined delay for funds transfer in cases in which a minimum balance was required to open an account or "open season" timing concerns existed for account opening. Additionally, Shurling et al specifically disclose concerns with vesting of award amounts, which would entail predetermined periods for award grant.

As to Claim 16, Ferguson et al disclose the first financial account as a pooled account at Col. 10, lines 25-40. This pooled account is read as the equivalent of a saving account in that it "saves" award amounts for later distribution to customers.

As to Claim 17, Ferguson et al disclose the second financial account as a brokerage account at Col. 11, lines 23-35 and Fig. 1, ele. 30.

Concerning Claim 18, Ferguson et al disclose the brokerage account as a mutual fund at Col. 11, lines 29-31.

With respect to Claim 19, Ferguson et al disclose loan accounts, investment accounts and service accounts at Col. 1, lines 6-27.

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With respect to Claim 20, Ferguson et al disclose a loan account as a mortgage at Col. 1, line 19.

With respect to Claim 21, Ferguson et al disclose an investment account as a CD at Col. 1, lines 19-20.

With respect to Claim 22, Ferguson et al disclose a service account as an insurance account at Col. 1, line 20.

With respect to Claim 23, Shurling disclose the invention substantially as claimed including in a method for funding at least one account of a customer at a financial institution (Summary of the Invention), the steps of:

Contributing immediate access value (deposits in a checking account at Col 1, lines 6-27) and future access value (reduced service fees on such an account, e.g. reductions realized at the end of a month on an average daily balance at Col. 1, lines 6-27) to at least one customer, wherein the immediate access value is contributed by the customer (e.g. payroll deposits) and is accessible by the customer at all time and future access value is contributed by the financial institution and is accessible by the customer according to a vesting schedule (Col. 11, line 46 to Col. 12, line 35; Col. 15, lines 9-24). Shurling further suggests a negotiated value factor at Col. 11, line 46 to Col. 12, line 8; in this instance, increased activity results in more benefit to a participant.

Shurling does not specifically disclose inclusion of a third party and its relationships. Ferguson discloses relationships between a customer and a third party (Col. 6, lines 16-22 and collecting information from the third party and evaluation of relationship with the third party (Col. 6, lines 33-48). Ferguson discloses a further relationship between a customer and a bank as

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a bank account into which third party awards are transferred. See Ferguson at Col. 5, lines 41-46.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the customer-third party relationship and information in the awarding of value of Ferguson in the method of Shurling because this would have encouraged customers to complete transactions with a third party (Ferguson, Col. 1, lines 48-64, while providing a centralized and simple method of evaluating relationship activity (Shurling, Summary of the Invention). Additionally, the combination would have related participation levels to economic benefit and so encouraged participants to improve their participation.

Regarding Claims 4-5, see the discussion of Claim 12 above.

Regarding Claim 6, Shurling discloses a customer relationships with credit card and insurance providers at Col. 1, lines 5-27. It would have been obvious to have allowed third parties to provide such service relationships because this would have increased market share for the program.

With respect to Claims 9-11, see the discussion of Claims 16-18 set forth above.

Response to Arguments

Applicant's arguments filed August 23, 2002 have been fully considered but they are not persuasive.

Applicants' arguments regarding Claim 12 have been addressed in the rejection of Claim 12 set forth above. See particularly the added discussion of immediate access account values (checking account balances) and vested value (reduced checking account fees) set forth above.

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As to Applicants' arguments on Claim 3, the Examiner observes that Ferguson discloses both relationships between a customer and a bank (e.g. an IRA account held in an account at a bank; Col. 5, line 41 to Col. 6, line 15) and a customer and a third party (a patronage incentive system between a customer and a third party). In this arrangement, an award is based on the relationship between the customer and the third-party sponsor and processed through a financial institution account based on a relationship between the customer and the financial institution. See particularly Ferguson Col. 6. line 33 to Col. 7, line 5.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles R Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on M-F 6:00-2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



crk

November 4, 2002


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